

## **II. REMARKS**

Claims 1-13, 27, and 29-40 are pending in the present application. Claims 2, 14-26, 28-29, and 37-38 are canceled.

Claim 1 is amended to incorporate features and limitations from claim 2. Support for this amendment may be found in at least the previous version of claims 1 and 2, FIG. 6, and Specification page 8 line 20 through page 9, line 14. Claim 1 is also amended to recite “displaying the first web page bit map image fragment on the display screen.” Support for this amendment may be found in at least FIG. 6 and Specification page 12, lines 1-3. No new matter has been entered.

Claim 27 is amended to incorporate features and limitations from claims 29 and 37-38. Support for this amendment may be found in at least the previous version of claims 27, 29, and 37-38, FIG. 6, and Specification page 8, line 20 through page 9, line 14. No new matter has been entered.

Reconsideration of the claims is respectfully requested for the reasons set forth below.

### **Claim Rejections - 35 U.S.C. § 103, Obviousness**

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), *viz.*, (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a prima facie case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Furthermore, “‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007)

(quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)). Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444; *Piasecki*, 745 F.2d at 1472, 223 USPQ at 788.

*Claims 1, 3-13, 27, 30-36, and 39-40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tuli (Patent No. US 6,941,382 B1; hereinafter Tuli) in view of Aoki et al. (Pub. No. US 2003/0016253 A1; hereinafter Aoki.)*

### **Claims 1, 3-9, and 13**

Claim 1, as amended, recites “determining if the size of a web page is larger than a display screen.” The Examiner alleges Tuli teaches these limitations. Office Action p.5 (rejecting these limitations of claim 2 and citing to Tuli 2:34-38. Tuli fails to teach these limitations because Tuli is silent to “determining,” as set forth in the claim. Tuli teaches “the image 5 to be displayed in a browser window 6 is usually larger than the displayable area of the browser window 6” (Tuli 2:34-38), yet Tuli is silent to its system performing this determination. Rather, Tuli is merely describing its system, but not that its system makes any such determination. The mere statement that an image is larger than a displayable area, without more, fails to teach “determining if the size of a web page is larger than a display screen.” The cited portions of Aoki are not relied upon and do not teach these limitations.

Claim 1 also recites “responsive to a determination that the web page is not larger than the display screen, displaying the web page unmodified on the display screen.” Tuli fails to teach these limitations because Tuli is silent to “displaying the web page unmodified.” Tuli teaches its Browser Translator 4 translates a web page to a bit map or a raster image (Tuli 2:23-32), yet Tuli is silent to not using Browser Translator 4 to translate the web page. In other words, Tuli teaches displaying a modified web page (i.e., modified by Browser Translator 4), yet fails to teach displaying an unmodified web page (i.e., a web page displayed that has not been modified by Browser Translator 4). The cited portions of Aoki are not relied upon and do not teach these limitations.

Thus, the combination of cited art fails to teach all limitations of the claim. Therefore, Applicant respectfully requests that the rejection be withdrawn.

Claims 3-9 and 13 each depend from and inherit all the limitations of claim 1. As discussed above, claim 1 comprises features and limitations that are not taught by the combination of cited art. Thus, Claims 3-9 and 13 comprise features and limitations that are not taught by the cited art. Therefore, Applicant respectfully requests that the rejection be withdrawn.

#### **Claim 10**

In addition to the features and limitations inherited from claim 1 that are not taught by the combination of cited art, as discussed above, claim 10 also recites “wherein the proxy sends only one fragment to the hand held display device.” The Examiner admits Tuli fails to teach these limitations, but then alleges these limitations would be obvious in view of Tuli. Office Action p.5 (citing to Tuli 2:56-60). Applicant respectfully disagrees because Tuli teaches away from these limitations. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Tuli states “the compressed image, after being processed by program 11, is sent to the user” (Tuli 2:50-51), yet is silent to sending only one section of an image to the user. Tuli also teaches that the first section is “decompressed and displayed” and that the other sections are “decompressed and stored in an internal memory of the palm top device, to be displayed later when the user scrolls up, down, or sideways to these parts of the image.” Tuli 2:54-63. In other words, far from sending only one section at a time to its palm top device, Tuli teaches sending all sections to the palm top device, directly contradicting the claim’s language of “sends only one fragment at a time.” The cited portions of Aoki are not relied upon and do not teach these limitations. Thus, the combination of cited art fails to teach all the limitations of the claim. Therefore, Applicant respectfully requests that the rejection be withdrawn.

### **Claim 11**

In addition to the features and limitations inherited from claims 1 and 10 that are not taught by the combination of cited art, as discussed above, claim 11 also recites “responsive to receiving a request for another fragment, sending another fragment.” The Examiner alleges Tuli teaches these limitations. Office Action pp.7-8 (citing to Tuli 2:59-63). Applicant respectfully disagrees because Tuli teaches sending all fragments, thus precluding the requesting of subsequent fragments. Tuli states “the compressed image, after being processed by program 11, is sent to the user” (Tuli 2:50-51), yet is silent to sending only one section of an image to the user. Tuli also teaches that the first section is “decompressed and displayed” and that the other sections are “decompressed and stored in an internal memory of the palm top device, to be displayed later when the user scrolls up, down, or sideways to these parts of the image.” Tuli 2:54-63. In other words, far from sending one section to its palm top device and the palm top device requesting subsequent sections, Tuli teaches sending all sections to the palm top device, and thus fails to teach “responsive to receiving a request for another fragment, sending another fragment.” The cited portions of Aoki are not relied upon and do not teach these limitations. Thus, the combination of cited art fails to teach all limitations of the claim. Therefore, Applicant respectfully requests that the rejection be withdrawn.

### **Claim 12**

In addition to the features and limitations inherited from claim 1 that are not taught by the combination of cited art, as discussed above, claim 12 recites “the web page image is identified by a unique identifier.” The Examiner alleges Tuli teaches these limitations. Office Action p.8. Specifically the Examiner states “as well-known in the art at the time the invention was made, URL is used to identif[y] a web page from the internet or WWW.” However, the claim requires identifying a web page image, not the web page, which is not taught by the combination. Tuli does not expressly teach a URL that identifies a web page and Tuli is also silent to any identifier used to identify a “web page image.” Furthermore, that a URL identifies a web page fails to address identifying a web page image. The cited portions of Aoki are not relied upon and do not teach these limitations. Thus, the combination of cited art fails to teach all limitations of the claim. Therefore, Applicant respectfully requests that the rejection be withdrawn.

**Claims 27, 30-36, and 40**

Claim 27, as amended, recites “determining if the size of a web page is larger than a display screen.” The Examiner alleges Tuli teaches these limitations. Office Action p.5 (rejecting these limitations of claim 29 and citing to Tuli 2:34-38. Tuli fails to teach these limitations because Tuli is silent to “determining,” as set forth in the claim. Tuli teaches “the image 5 to be displayed in a browser window 6 is usually larger than the displayable area of the browser window 6” (Tuli 2:34-38), yet Tuli is silent to its system performing this determination. Rather, Tuli is merely describing its system, but not that its system makes any such determination. The mere statement that an image is larger than a displayable area, without more, fails to teach “determining if the size of a web page is larger than a display screen.” The cited portions of Aoki are not relied upon and do not teach these limitations.

Claim 27 also recites “responsive to a determination that the web page is not larger than the display screen, displaying the web page unmodified on the display screen.” Tuli fails to teach these limitations because Tuli is silent to “displaying the web page unmodified.” Tuli teaches its Browser Translator 4 translates a web page to a bit map or a raster image (Tuli 2:23-32), yet Tuli is silent to not using Browser Translator 4 to translate the web page. In other words, Tuli teaches displaying a modified web page (i.e., modified by Browser Translator 4), yet fails to teach displaying an unmodified web page (i.e., a web page displayed that has not been modified by Browser Translator 4). The cited portions of Aoki are not relied upon and do not teach these limitations.

Claim 27 also recites “wherein the proxy sends only one fragment to a hand held display device.” The Examiner admits Tuli fails to teach these limitations, but then alleges these limitations would be obvious in view of Tuli. Office Action p.7 (citing to Tuli 2:56-60). Applicant respectfully disagrees because Tuli teaches away from these limitations. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Tuli states “the compressed image, after being processed by program 11, is sent to the user” (Tuli 2:50-51), yet is silent to sending only one section of an image to the user. Tuli also teaches that the first section is

“decompressed and displayed” and that the other sections are “decompressed and stored in an internal memory of the palm top device, to be displayed later when the user scrolls up, down, or sideways to these parts of the image.” Tuli 2:54-63. In other words, far from sending only one section at a time to its palm top device, Tuli teaches sending all sections to the palm top device, directly contradicting the claim’s language of “sends only one fragment.” The cited portions of Aoki are not relied upon and do not teach these limitations.

Claim 27 also recites “responsive to receiving a request for another fragment, sending another fragment.” The Examiner alleges Tuli teaches these limitations. Office Action pp.7-8 (citing to Tuli 2:59-63). Applicant respectfully disagrees because Tuli teaches sending all fragments, thus precluding the requesting of subsequent fragments. Tuli states “the compressed image, after being processed by program 11, is sent to the user” (Tuli 2:50-51), yet is silent to sending only one section of an image to the user. Tuli also teaches that the first section is “decompressed and displayed” and that the other sections are “decompressed and stored in an internal memory of the palm top device, to be displayed later when the user scrolls up, down, or sideways to these parts of the image.” Tuli 2:54-63. In other words, far from sending one section to its palm top device and the palm top device requesting subsequent sections, Tuli teaches sending all sections to the palm top device, and thus fails to teach “requesting another fragment.” The cited portions of Aoki are not relied upon and do not teach these limitations.

Thus, the combination of cited art fails to teach all limitations of the claim. Therefore, Applicant respectfully requests that the rejection be withdrawn.

Claims 30-36 and 40 each depend from and inherit all the limitations of claim 27. As discussed above, claim 27 comprises features and limitations that are not taught by the combination of cited art. Thus, Claims 30-36 and 39-40 comprise features and limitations that are not taught by the cited art. Therefore, Applicant respectfully requests that the rejection be withdrawn.

### **Claim 39**

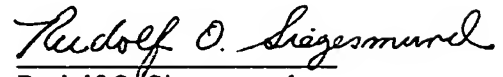
In addition to the features and limitations inherited from claim 27 that are not taught by the combination of cited art, as discussed above, claim 39 recites “the web page image is

identified by a unique identifier.” The Examiner alleges Tuli teaches these limitations. Office Action p.8. Specifically the Examiner states “as well-known in the art at the time the invention was made, URL is used to identif[y] a web page from the internet or WWW.” However, the claim requires identifying a web page image, not the web page, which is not taught by the combination. Tuli does not expressly teach a URL that identifies a web page and Tuli is also silent to any identifier used to identify a “web page image.” Furthermore, that a URL identifies a web page fails to address identifying a web page image. Thus, the combination of cited art fails to teach all limitations of the claim. Therefore, Applicant respectfully requests that the rejection be withdrawn. The cited portions of Aoki are not relied upon and do not teach these limitations.

**Conclusion**

Applicant submits that the claims are now in condition for allowance.

Respectfully submitted,



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